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EXAMINER

SHAN, APRIL YING

ART UNIT	PAPER NUMBER
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2135

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/667,872

Applicant(s)

NAKANO, TAKEHIKO

Examiner

April Y. Shan

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-15 and 17-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Amendment/Argument

1. The Applicant's amendment, filed 15 October 2007, has been received, entered into the record, and respectfully and fully considered.

2. As a result of the amendment, claims 1, 2, 4, 6-13, 17-23 have been amended. Claims 5 and 16 are cancelled. Claims 1-4, 6-15 and 17-23 are now presented for examination.

3. Applicant's amendments and argument have been fully considered and it is noted that Applicant's arguments are directed towards limitations newly added via amendments.

4. The Applicant argues the prior art does not disclose "replacing the first user identification information with a second user identification information to register a second user requesting use of the content" and "limitation modifying means for modifying the limitation on replacing user identification information", the examiner respectfully disagree.

First, please see below drawings objection and 112 rejections on the newly added claim limitations.

Second, please see fig. 7 and 8 in Ansell et al. reference does disclose replacing the first user identification information with a second user identification information to register a second user requesting use of the content. Further, Lauper et al. does disclose "Performing transactions depends on several **time-limited** parameters...have to be **updated**..." - abstract, col. 1, lines 15-30, col. 2, lines 38-47, col. 4, lines 23-46

and claim 1 on limitation modifying means for modifying the limitation on replacing user identification information. Furthermore, "update" in the Lauper et al. reference means replacing old time-limited parameters with new-time limited parameters.

Third, all the dependent claims are not allowable since arguments towards independent claims 1 and 12 are traversed. Further, Ansell et al. discloses in col. 17, lines 24-58, wherein the limitation is a maximum number of times user identification information can be replaced "...to be re-issued....if re-issue of machine-bound passport are allowed, the number of times such re-issue is permitted can be limited". Furthermore, "reissue" in the Ansell et al. reference means replacing old machine-bound passport with new machine-bound passport.

Finally, the Applicant is respectfully reminded that One cannot show nonobviousness by attacking references individually where the rejections are based on **combination** of references. See *In re Keller*, 642 F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

5. Any objections or rejections not repeated below for record are withdrawn due to Applicant's amendment/explanation/cancellation.

Drawings

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the amended claims 1, 12 and 23 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

Correction of the following is required: "A computer – readable medium" of claim 23 lacks antecedent basis in the specification.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-4, 6-15 and 17-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per **claims 1, 12 and 23**, the examiner respectfully and carefully reviewed the original disclosure and cannot find any support for the amended claim limitations, such as replacing the first user identification with a second user identification information to register a second user requesting use of the content, preventing further replacement of the registered second user identification information in accordance with a limitation on replacing user identification information and etc. Please clarify.

Any claim not specifically addressed, above, is being rejected as incorporating the deficiencies of a claim upon which it depends.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-4, 6-15 and 17-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **claims 1, 12 and 23**, "requesting use of the content" is being recited.

However, this claim limitation lacks of antecedent basis.

Any claim not specifically addressed, above, is being rejected as incorporating the deficiencies of a claim upon which it depends.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 23 recites a computer-readable medium. However, the original disclosure does not expressly define/discloses a computer-readable medium. To a person with ordinary skill in the art, a computer-readable medium can include communication media, such as signal, carrier wave and etc. This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category

since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter. **Please note any amendment should be commensurate with its corresponding disclosure.**

Claim Rejections - 35 USC § 103

13. Claims 1-4, 6-15 and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ansell et al. (U.S. Patent 6,792,113) and in view of Lauper et al. (U.S. Patent 6,726,100).

As per **claims 1, 7, 12 and 18**, Ansell et al. discloses a content usage control apparatus/method for controlling use of a content under a predetermined condition, comprising:

acquiring first user identification information for a first user requesting use of the content ("authentication server sends an information template for new machine bound passports. An information template is a collection of data specifying user-supplied data fields and prompts therefore. The information template is an XML description of the data to collect from the user... Such information can be entered by the user using conventional user-interface techniques. Processing transfers to step 810" – e.g. col. 16, lines 37-50, fig. 7, "user-binding" – e.g. abstract, "In user-binding,... By requiring the password, the

content is bound to the user in possession of the password...Specifically, the user-bound passport includes information which is expected to be carefully guarded by the user..." - e.g. col. 2, line 54 - col. 3, line 9);

registering the first user identification information ("In step 810, content player 142 sends hardware identifier 140 and any user-supplied information to authentication server 126 as a request for a new machine-bound passport... Logic flow diagram 900 (fig. 9) illustrates processing by authentication server 126 (fig. 1) in response to a request for a new machine-bound passport made by content player 142 in step 810 (fig. 8)... authentication server 126 associates the new certificate with the received hardware identifier, within certificate database..." - e.g. col. 16, lines 53-67 - col. 17, lines 1-23, "In user-binding,... By requiring the password, the content is bound to the user in possession of the password... Specifically, the user-bound passport includes information which is expected to be carefully guarded by the user..." - e.g. col. 2, line 54 - col. 3, line 9);

replacing the first user identification information with a second user identification information to register a second user requesting use of the content (e.g. fig. 7 and fig. 8) and preventing further replacements to the registered second user identification information in accordance with a limitation on replacing user identification information (e.g. col. 17, lines 27- 58);

in response to the request for use of the content issued by the second user, determining whether the use of the content is allowed on the basis of whether the

second user identification information is currently registered ("content player determines whether the entered password corresponds to the full passport. If the password corresponds to the selected full passport, processing transfers to step 708 in which processing of the purchase for content continues" – e.g. col. 15, lines 13-16 and col. 15, lines 23-28; "content player determines whether hardware identifier is the hardware identifier corresponding to the machine-bound passport located by content player. If hardware identifier is the correct identifier, processing transfers from test step 714 to step 708 and the purchase process continues and any purchased content is bound to a machine-bound passport" – e.g. col. 15, lines 56-59, col. 16, lines 9-13, col. 18, lines 9-24, fig. 7 and fig. 10).

Ansell et al. does not expressly disclose modifying the limitation on replacing user identification information and the limitation can be a predetermined period of time.

However, Lauper et al. discloses modifying the limitation on replacing identification information and the limitation can be a predetermined period of time (e.g. abstract, col. 1, lines 15-30, col. 2, lines 38-47, col. 4, lines 23-46 and claim 1)

Thus, it would have been obvious to a person with ordinary skill in the art to apply the technique of modifying the limitation on replacing identification information and the limitation can be a predetermined period of time as taught in the Lauper et al's reference, to improve the a content usage control apparatus/method of Ansell et al. for the predictable result of provide

convenience to purchasers of digital data since purchasers of digital data have a relatively low tolerance for inconvenience, in particular, when a user loses a machine-bound passport.

As per **claims 2 and 13**, Ansell et al. – Lauper et al. disclose a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses registration is performed in response to a request issued by the first client (e.g. logic flow diagram 718 in fig. 8 and logic flow diagram 900 in fig. 9).

As per **claims 3 and 14**, Ansell et al. – Lauper et al. disclose a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses new registration is performed only when a current number of registrations is smaller than a predetermined maximum allowable number of registrations ("logic flow diagram by authentication server in response to a request for a new passport which includes full passport information... Typically, full passports are permitted to hold only a limited number of additional keys such that users cannot collect machine-bound keys and content from friends and colleagues without limitation. Passport key limit 1912 specifies a maximum number of keys held by a passport based upon key record. Authentication server

compares the number of keys already held in the full passport of the user to the limit specified in passport key limit to determine whether the passport can include more keys" – e.g. col. 22, lines 3-48 and step 912 in fig. 9).

As per **claims 6 and 17**, Ansell et al. – Lauper et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses wherein the limitation is a maximum number of times user identification information can be replaced (e.g. col. 17, lines 24 - 58).

As per **claims 8 and 19**, Ansell et al. – Lauper et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses wherein when the registered first identification information for the first client is replaced with second identification information for a second client, the second client is requested to perform a particular operation ("In addition, since the user-bound passport is not bound to any particular hardware identifier, the content and the user-bound passport can be moved from computer system to computer system and can be played back with only the effort required to enter the user's password and to view the user's private information" – e.g. col. 3, lines 40-46).

As per **claims 9 and 20**, Ansell et al. – Lauper et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al.

further discloses wherein when the registered first identification information is replaced with second identification for a second client, submission of change permission information is requested from the second client or manager ("Logic flow diagram 900 (fig. 9) illustrates processing by authentication server in response to a request for a new machine-bound passport made by content player in step 810 (fig. 8) "– e.g. col. 16, lines 58-61).

As per **claims 10 and 21**, Ansell et al. – Lauper et al. discloses a content usage control apparatus/method as applied in claims 6 and 17. Ansell et al. further discloses charging fees for changing the maximum number of times identification information can be replaced (e.g. col. 3, lines 3-9, col. 17, lines 39-58, col. 10, lines 60-63, col. 21, lines 9-19).

As per **claims 11 and 22**, Ansell et al. – Lauper et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses when the limitation is modified, submission of change permission information is requested from a different apparatus or a manager ("Logic flow diagram 900 (fig. 9) illustrates processing by authentication server in response to a request for a new machine-bound passport made by content player in step 810 (fig. 8) "– e.g. col. 16, lines 58-61).

As per **claim 23**, Ansell et al. – Lauper et al. discloses the claimed method of steps as applied above in claim 1. Therefore, Ansell et al. – Lauper et al. discloses the claimed for computer program described in a computer-readable format carrying out the method of steps.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AYS
6 January 2008
AYS

Thanhnga B. Truong

THANHNGA TRUONG
PRIMARY EXAMINER